

Application No. 09/617,340
Amendment Dated July 2, 2003
Reply to Office Action dated May 22, 2003

REMARKS

By this Amendment, Claim 29 is amended and Claims 39-82 have been cancelled. Claims 29, 31-38 are pending.

The Examiner has rejected Claims 29, 34, 35, 36 and 37 under 35 U.S.C. §102 (a) as being anticipated by WO 94/11041 (Galli):

...Galli discloses a syringe comprising a barrel, needle, energization source 22, actuator, spring retractor 36, 412 biasing the sleeve, and nozzle sleeve moveably mounted at the first end of the barrel from a first position with needle concealed to second position with needle exposed, to a third activation position where said energization source is activated to move a piston to drive liquid from the reservoir through the needle (pg 11, lines 9-21, p. 17, lines 9-36; Figs. 13, 14).

The Examiner also adds that:

Applicant argues that Galli does not show a sleeve mounted at the first end of the barrel. The examiner disagrees and maintains that Figs. 1, 2, 4-6, 13, and 14 of Galli show a sleeve mounted at the first end of the barrel. In this regard "mounted at" is construed as placed on. If Applicant is arguing that "mounted at" means some connection at the distal end of the barrel, then examiner points out that this arrangement is not shown in the drawings or described in the specification and would be considered new matter.

Applicant argues that Galli does not show a spring between a needle and sleeve. The claims recite a needle between a needle assembly and sleeve which is shown in Galli, Figs. 13, 14.

However, Applicants respectfully disagree for the following reasons. Attached herewith as Exhibits A and B are marked-up figures from the present application and U.S. Patent No. 5,681,291 (Galli, which corresponds to WO 94/11041), respectively, to better illustrate the difference between these two devices and how Claim 29, as amended, specifies these differences.

In particular, as can be seen in Figs. 3-4 (Exhibit A) of the present application, a nozzle sleeve 20 is displaceable from a pre-use position (Fig. 3) to a use position (Fig. 4). This nozzle sleeve 20 is mounted at¹ the first end of the barrel 11. When the nozzle sleeve 20 is pressed against the skin, the sleeve 20 moves upward, into the barrel 11, acting against the bias of a coil spring 22. This arrangement is completely disclosed in the present application, both in the Specification and throughout the figures, and does not form any new matter whatsoever.

In contrast, as can be seen in Figs. 1-2 (Exhibit B) of Galli, a slider 5 (sleeve) moves to expose (Fig. 2) or conceal (Fig. 1) a needle 10, but the slider 5 is not mounted at the first end of the syringe 4 or the cylindrical body 1 (similar to barrel 11 of the present application); instead, if anything, the slider 5 comprises a shoulder 11 that impacts with a detent ring 9 (hereinafter "location 1") to prevent any further movement of the slider 5 (Fig. 2), not to mention the upper end of the slider 5 (see near annular projection 7) which interacts with cylindrical body 1 (e.g., annular retaining shoulder 6) at its upper end (hereinafter "location 2"). As a result, the slider 5 is not mounted at the first end of the cylindrical body 1 but rather is mounted at location 1 and/or location 2. Thus, one important distinction is that the slider 5 is not mounted at the first end of the cylindrical body 1 (see Figs. 1- 2 of Exhibit B²). Moreover, the slider 5 slides over the cylindrical body 1/syringe 4, not

¹Present Application, p. 12: A displaceable sleeve 20 is moveably mounted at the opposite, open end 19 of the barrel 11.

²The Galli device of Figs. 4-6 operate in a similar manner and thus it too does not disclose a nozzle sleeve mounted at the first end of the cylindrical body 1/syringe 4, nor the slider 5 slide inside the cylindrical body 1/syringe 404. The Galli device of Figs. 13-14 includes a slider 405 that does not slide inside the cylindrical body/syringe 404.

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inside of the cylindrical body 1/syringe 4. Thus, for all of these reasons, and in view of the amendment to Claim 29, Applicants respectfully submit that Claim 29 is patentable over the art of record and respectfully request that the §102 (a) rejection be withdrawn.

Claim 34 is dependent upon Claim 29 and is patentable for the same reasons.

Claim 35 is dependent upon Claim 29 and is patentable for the same reasons.

Claim 36 is dependent upon 35 and is patentable for the same reasons.

Claim 37 is dependent upon Claim 29 and is patentable for the same reasons. Moreover, the slider of Galli does not move axially and rotationally relative to the barrel between the first position and the second position. Thus, for all of these reasons, Claim 37 is patentable over Galli and Applicants respectfully request that the §102 (a) rejection be withdrawn.

The Examiner has rejected Claims 31-32 under 35 U.S.C. §103(a) as being unpatentable over Galli as applied to Claim 29 and further in view of U.S. Patent No. 5,540,665 (Mercado et al.). However, Applicants respectfully submit that because Claims 31 and 32 ultimately depend from Claim 29, they are patentable for the same reasons and, as a result, Applicants respectfully request that the §103(a) rejection be withdrawn.

For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

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Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

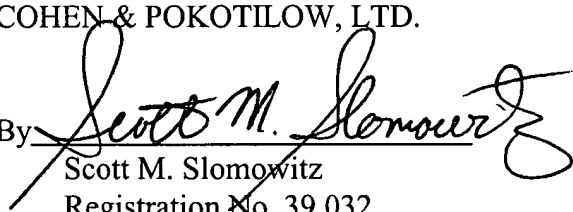
Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.

July 2, 2003

Please charge or credit our Account
No. 03-0075 as necessary to effect
entry and/or ensure consideration of
this submission.

By


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